

Appln. No. 10/029,326

Attorney Docket No. 10541-282

II. Remarks

In response to the Office Action mailed December 23, 2005, kindly enter the foregoing amendment and consider the following remarks. An appropriate petition for a one month extension of time, with fee, is enclosed herewith. This response is being filed within the extended deadline. Pursuant to 37 CFR §1.112, Applicant requests reconsideration of each and every ground of rejection set forth in the Office Action.

The Office Action and the references cited therein have been carefully considered. In this Amendment, claims 1, 7, 11, 15, 21 and 22 have been amended. Thus claims 1-26 are pending and are at issue herein. In view of these amendments and the following remarks, favorable reconsideration of this application is requested.

EXAMINER INTERVIEW

The Applicant would like to thank the Examiner for conducting a telephonic interview on March 14, 2006. In the interview, the independent claims were discussed with reference to the Janik reference. While several points were generally agreed to, the Applicant is filing as Request for Continued Examination along with this amendment to allow the Examiner further consideration of the art in view of the interview, as well as the amendments and remarks made herein which are consistent with that interview. Favorable consideration of all the claims is respectfully requested.

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CLAIM REJECTIONS UNDER 35 USC §103

Claims 1-3, 8-11 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Janik reference (U.S. Patent Application Publication No. 2002/0164973) in view of the Dwyer reference (U.S. Patent No. 6,671,567). Claims 4-7, 12-13 and 15-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Janik reference in view of the Dwyer reference and further in view the PC Works reference.

With regard to independent claim 1, a personal computer bus is recited which provides a shared common pathway for transmitting data directly between the storage medium and the data expander and the audio output and the network interface. In the final Office Action and the Examiner Interview, the Examiner submitted that: (1) the circuit board of the Janik reference is a computer bus because many of the components are interconnected through the circuit board in Janik, and (2) even if direct point to point connections between the components are assumed, these devices must communicate to each other through the microprocessor, and (3) even if Janik fails to disclose a computer bus, that a computer bus is not a patentable distinction, i.e., that it would be obvious to modify Janik to include a computer bus.

With regard to the Examiner's first point, and as discussed in the interview, all the definitions of personal computer bus cited by both the Examiner and the Applicant all share the fact that a personal computer bus provides a shared common pathway. It is respectfully submitted that neither a circuit board, nor a ribbon cable, both of which provide direct point to point communications and in the Janik reference do not provide a shared pathway, are therefore not considered a personal computer bus providing a shared common pathway. With regard to the Examiner's second point, the fact that these devices communicate through a microprocessor is unsupported, and even if true it is well known in the art that a microprocessor is not the same or equivalent as a personal computer bus, with or without a circuit board. For example, by virtue of the shared common pathway of the personal computer bus in claim 1, encoded audio data files on the storage medium could be played through the apparatus itself to via the audio output, and likewise can be simultaneously transferred over the network. Given this example, it is clear that the Janik reference

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does not include the structure of a personal computer bus which achieves the benefits of the present invention. With regard to the Examiner's third point, the Applicant refers the Examiner's attention to the recent Federal Circuit case of *In re Kahn* (04-1616) decided March 22, 2006, which says that the reasoning for modifying or combining references must be explained. The Applicant also notes that MPEP § 2144.03 that it is insufficient to merely state that certain features or modifications are "common knowledge" without evidentiary support, and likewise MPEP § 2143.91 which states that the mere fact that references can be combined is insufficient to prove motivation for the combination and therefore fails to prove obviousness.

For all these reasons, favorable reconsideration of independent claim 1 as well as its dependent claims, is respectfully requested.

With regard to independent claim 11, a personal computer network interface provides transfer of encoded audio files from the storage means to an external device over a network and providing local playback of decoded audio files over the network without the need to copy the encoded audio data files to the external device. Support for these features may be found in paragraph [0007] of the specification. As discussed in the interview, none of the references disclose a device that is capable of local playback of decoded audio files over the network. In this manner, the apparatus of the present invention provides the ability to use the apparatus as the single storage location of all audio data without the need to replicate this data on each device that desires to use the audio data. Favorable reconsideration of independent claim 11, as well as its dependent claims, is respectfully requested.

With regard to independent claim 15, the claim recites a network protocol allowing access the storage medium when the apparatus is operating as an addressable member of a computer network, and specifically a wide or local area network and having a network address. Claim 15 also recites that the apparatus functions as a server on the network to transmit data to another device over the computer network. As noted in the Examiner's Interview Summary, it has been agreed that the prior art of record fails to disclose these and other features of independent claim 15. For all these reasons, reconsideration of independent claim 15, as well as its dependent claims, is respectfully requested.

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The Applicant also refers the Examiner's attention to claim 7 which is clearly not shown in the prior art.

CONCLUSION

In view of the preceding amendments and remarks, the Applicant respectfully submits that the specification is in order and that all of the claims are now in condition for allowance. If the Examiner believes that personal contact would be advantageous to the disposition of this case, Applicant respectfully requests that the Examiner contact the Attorney of the Applicant at the earliest convenience of the Examiner.

4/24/06
Date

Respectfully submitted,

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